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OFFICE OF PETITIONS

In re Application of	:	
Ralph W. Blakemore	:	
Application No. 09/657,883	:	ON PETITION
Filed: 8 September, 2000	:	
Attorney Docket No. 6097.P022	:	

This is a decision on the petition, filed on 9 November, 2004, under 37 CFR 1.137(a), and, in the alternative under 37 CFR 1.137(b) to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The application became abandoned on 22 November, 2003, for failure to timely file the issue fee as required by the Notice of Allowance and Issue Fee Due mailed on 21 August, 2003, which set a three (3) month statutory period for reply. Petitioner filed an RCE on 25 November, 2003. On 3 May, 2004, however, a Notice of Improper Request for Continued Examination (RCE) was mailed, stating that the RCE was improper because it was not accompanied by a submissions as required by 37 CFR 1.114.

Petitioner asserts unavoidable delay in that petitioner was informed by the examiner that a one (1) month period for reply to the Notice of Improper RCE existed, although the time period for correcting the deficiencies in the RCE had already passed, and the case had become abandoned, by the time petitioner received the aforementioned Notice was received.

PETITION UNDER 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee as set forth in § 1.17(1);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3) above.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to be "unavoidable".¹ Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its

¹35 U.S.C. § 133.

rectification being present.²

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).³ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

Although the PTO attempts to notify parties as to defective papers in order to permit timely refiling, it has no obligation to do so.⁵ Rather, it is the applicant who is ultimately responsible for filing proper documents.⁶ That is, applicant was responsible for filing a proper submission under 37 CFR 1.114 with the RCE but failed to do so. While such a mistake may be unintentional, it does not rise to the level of unavoidable delay.

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.⁷ A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral

²In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quiqq, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

³See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

⁴Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁵See In re Columbo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994).

⁶Id.

⁷See Haines v. Quiqq, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.⁸

As petitioner has presented no showing of unavoidable delay, the petition will be dismissed.

As petitioner has request treatment under 37 CFR 1.137(b) in the alternative, the petition will be considered under 37 CFR 1.137(b).

PETITION UNDER 37 CFR 1.137(b)

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof;
- (2) the petition fee required by 37 CFR 1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and
- (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)).

The amendment after allowance filed on 27 May, 2004, will be considered as the reply required under 37 CFR 1.114.

Receipt of the issue fee transmittal form filed on 26 January, 2005, is acknowledged. 37 CFR 1.137(b)(1) states, that in an application abandoned for failure to pay the issue fee, the required reply must be the payment of the issue fee or any outstanding balance thereof. As such the issue fee, and the publication fee, will be charged to counsel's deposit account, No. 02-2666, as authorized on the fee transmittal form filed with the present petition. If the application is subsequently

⁸See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

allowed, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee required by the new notice of allowance.⁹

Receipt of the statement indicating a loss of Small Entity status filed on 26 January, 2005, is acknowledged. Small Entity status will no longer apply.

The petition fee under 37 CFR 1.137(b) has been charged to counsel's deposit account as authorized in the present petition.

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

The application is being referred to Technology Center Art Unit 3745 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



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⁹ The request to apply the issue fee to the new Notice of Allowance must be made in writing and should be accompanied by the new Issue Fee Transmittal Form (PTOL-85(b)), along with a copy of this decision. Additionally, if the issue fee has increased from the previously paid issue fee, the balance due at the time of payment must be submitted. Failure to timely request in writing that the previously paid issue fee be applied towards the new Notice of Allowance and payment of any balance due will result in the abandonment of the application.